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Geoffrey Flagstad

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MORGAN, ROBERT W

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEOFFREY FLAGSTAD

Appeal 2009-005845
Application 10/679,749
Technology Center 3600

Decided: February 25, 2010

Before KENNETH W. HAIRSTON, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

An oral hearing was held on Nov. 5, 2009.

STATEMENT OF THE CASE

Geoffrey Flagstad (Appellant) seeks our review of the final rejection of claims 1, 2, and 5-64 under 35 U.S.C. § 134. Claims 3 and 4 have been cancelled. Br. 5. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM but denominate the affirmed rejections as NEW GROUNDS OF REJECTION and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).¹

THE INVENTION

The invention “relates generally to a method and apparatus for obtaining and storing medical records of a patient from an entity covered by the Health Insurance Portability and Accountability Act of 1996 ("HIPAA") in a form allowing quick disclosure of the patient's medical history to a third party without restriction or delay by HIPAA.” Specification: [0001].

The independent claims are method claims 1 and 19 and system claim 30, on which claims 2, 5-18, 50-54; claims 20-29, 55-59; and, claims 31-49, 60-64 depend, respectively. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

¹ Our decision will make reference to the Appellant's Appeal Brief (“Br.,” filed Jan. 24, 2008) and the Examiner's Answer (“Answer,” mailed May 13, 2008).

1. A method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

A. inducing said patient to receive said medical record from a covered entity;

B. receiving said medical record from said patient in a storage format, without data processing said medical record;

C. storing said medical record in a memory in a form from which said medical record can be reproduced in said storage format, without data processing said medical record;

D. obtaining agreement in advance with the patient that the service provider shall transmit said medical record to a third party under defined conditions; and

E. transmitting said medical record to a third party when the defined conditions occur, without data processing said medical record.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Joao	US 6,283,761 B1	Sep. 4, 2001
Segal	US 2001/0041991 A1	Nov. 15, 2001
Mok	US 2003/0140044 A1	Jul. 24, 2003
Judson	US 2005/0026117 A1	Feb. 3, 2005

Official Notice: Examiner takes Official Notice that the technique of having one party (*e.g.*, intermediary, middle man, straw man, etc.) perform certain actions on behalf of another party through an agreement is notoriously well

known and obvious. For example, a power of attorney, a proxy agreement, and executor/trustee agreements, are commonly used to obtain an agreement in advance between multiple parties to consummate an agreed course of action (*e.g.*, transmission of medical records, etc.). Moreover, these techniques were developed and used prior to Applicant's invention to facilitate transactions. Answer 5-6.

The following rejections² are before us for review:

1. Claims 1, 2, 5-8, 11-32, and 35-64 are rejected under 35 U.S.C. §103(a) as being unpatentable over Segal, Joao, and Official Notice.
2. Claims 33 and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Segal, Joao, Official Notice, and Judson.
3. Claims 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Segal, Joao, Official Notice, and Mok.

ISSUES

The issue is whether the cited prior art would have led one of ordinary skill in the art to a method whereby a service provider induces a patient to receive a medical record from a covered entity; receives and stores the medical record “without data processing said medical record”; obtains agreement in advance with the patient such

² A prior rejection of claims 1, 2, and 5-64 are rejected under 35 U.S.C. §101 as being directed to nonstatutory subject matter has been withdrawn. Answer 13.

that the service provider shall transmit the medical record to a third party under defined conditions; and, transmits the medical record to the third party “without data processing said medical record” (claim 1), or a method and system whereby the service provider induces a patient to obtain possession of a medical record from a covered entity; convert the medical record into a storage format; and store the medical format in the storage means “without data processing said medical record by the service provider” (claims 19 and 30).

There is also an issue as to the adequacy of the written descriptive support for the claim limitation “without data processing said medical record” in the originally-filed Specification.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. The claims call for a “service provider.”
2. The Specification defines “service provider” as “the person(s) or entity(ies) carrying out this method [who] induces a patient to obtain possession of his or her own medical record from a covered entity.” Specification [0015].
3. Claims 1 and 19 state that a “service provider” “is not the patient or a covered entity.”

4. “[C]overed entities” are “physicians, hospitals, health care clearinghouses (“HCCs”), or other health care entities [which] cannot release medical information or records about an individual to third parties without written permission by that individual.” Specification [0006]
5. Accordingly, a “service provider,” as claimed, can be any person or entity who is not a patient or a covered entity but who induces a patient to obtain possession of his or her own medical record from a covered entity.
6. Step A. of claim 1 calls for the service provider to induce a patient to receive a medical record from a covered entity.
7. “Inducing” means “persuading.” (*See Webster’s New World Dictionary* 689 (3rd College Ed. 1988.)(Entry for “induce.”)
8. Persuading (*i.e.*, inducing) another person to obtain information is a well-known human activity.
9. For example, where the patient is a family member and the covered entity is a physician, it is well known for another family member (*i.e.*, a service provider) to persuade the patient family member to receive a medical record from the patient family member’s physician. This is commonly the case when the patient’s health is of concern to the patient’s family.
10. A more specific example: Where the patient is a child and the service provider is the child’s parent, it is well known for the parent to induce the child to receive a medical record from the child’s doctor. Similarly, it is well known for one spouse

- (service provider) to induce another spouse to receive a medical record from the spouses' doctor.
11. Step B. of claim 1 calls for the service provider to receive the medical record from the patient in a "storage format."
12. According to the Specification:
- [0016] The service provider then acquires the medical record from the patient in a storage format. ("Storage format" identifies the form of the record when it is acquired from the patient by the service provider.) The storage format of the medical record may be the same as or different from the format of the medical record maintained by a covered entity or originally received by the patient. For one example, the service provider can acquire the record from the patient in the same format in which the covered entity provided the record to the patient. As another example, the patient can provide to the service provider a record that has been summarized, abstracted, retyped, redacted, supplemented, converted from paper to electronic form or vice versa, or otherwise modified from its original form.
13. Accordingly, in light of the Specification, "storage format" means anything in any form that contains the medical record.
14. Accordingly, "storage format" could, for example, encompass an electronic file stored on a recordable CD.
15. Electronic files, be they medical records or of other content, stored on recordable CDs are well known.
16. Step C. of claim 1 calls for the service provider to store the medical record "in a memory in a form from which said medical record can be reproduced in said storage format."

17. According to the Specification, the “data storage medium, *i.e. the memory*, used by the system may be a portable medium such as a CD or DVD” [0027] Emphasis added.
18. It is well known that information from recordable CDs “can be reproduced” (Step C.) on the CDs.
19. Accordingly, Step C. broadly covers a service provider maintaining the medical record on the recordable CD received from the covered entity via the induced patient.
20. Claim 1 requires the service provider to perform Steps B. and C. “without data processing said medical record.”
21. The Specification does not disclose the phrase “without data processing said medical record” or explain what it means.
22. One common definition for “data processing” is “preparing, storing, or manipulating information.” (*See Webster’s New World Dictionary of Computer Terms* 146 (8th Ed. 2000.)(Entry for “data processing.”))
23. Accordingly, Steps B. and C. of claim 1 require the service provider to receive the medical record from the patient on, for example, a recordable CD and to maintain the medical record on the recordable CD without “preparing, storing, or manipulating” the medical record.
24. Step D. of claim 1 calls for the service provider to obtain “agreement in advance with the patient that the service provider shall transmit said medical record to a third party under defined conditions.”

25. The “defined conditions” are not specified and therefore broadly encompass any reason for transmitting the medical record to a third party.
26. The “third party” covers anyone. *See* Specification [0051]: “the service provider can obtain the agreement of the patient to allow transmission of the medical record to a health care provider, a relative, or another third party under defined conditions.”
27. Accordingly, where the patient is a child and the service provider is the child’s mother and the mother persuades the child to receive a medical record from the child’s doctor, Step D. covers the mother obtaining the agreement from the child to allow transmission of the medical record to the child’s father when the father asks for it.
28. Step E. of claim 1 calls for the service provider *transmitting* the medical record to the third party when the defined conditions occur, “without data processing said medical record.”
29. Step E. does not limit the storage format in which the medical record is transmitted. The step covers transmitting the medical record in any form by any means.
30. “Transmitting” means “to send or cause to go from one person or place to another.” (*See Webster’s New World Dictionary* 1421 (3rd College Ed. 1988.)(Entry for “transmit.”))

31. It is well known to send information without “preparing, storing, or manipulating” (*i.e.*, “without data processing”) the information.
32. In the example of FF 27 above, Step E. therefore broadly covers a mother sending the child’s medical record to the father when the father asks for it.
33. Claim 19 is drawn to a method broader in scope than claim 1.
34. The method of claim 19 requires the service provider to induce (*i.e.*, persuade) a patient to (A.) obtain possession of a medical record from a covered entity; (B.) convert the medical record into a storage format; and (C.) store the medical format in the storage means “without data processing said medical record by the service provider.”
35. Converting information from paper to an electronic form is well known (*e.g.*, via a scanner).
36. In the example of FF 27 above, claim 19 broadly covers a mother persuading a child to (A.) obtain a paper version of a medical record from the child’s doctor; (B.) convert the medical record into electronic form; and, (C.) store the medical record on a recordable CD.
37. Claim 30 is a “system” claim comprising a communication interface and a data storage device comprising a memory capable of performing the steps of claim 19.
38. A “communication interface” broadly covers a cell phone.

The scope and content of the prior art

39. Segal relates to a system for managing patient medical records.
40. Segal describes medical records ([0005]) and they are “stored in traditional paper-based formats” ([0007]).
41. Segal discloses a system that provides an ability for patients to obtain medical records from covered entities (e.g., physicians) via electronic means. *See* [0012], [0014], and [0151].
42. Joao relates to methods and apparatuses for providing healthcare information to patients.
43. Joao discloses “a patient or individual user communication device or computer which is associated with a healthcare patient such as a patient, user, or client who seeks or who is provided with healthcare ... information.” Col. 3, ll. 17-21.
44. Healthcare providers provide the healthcare information. Joao, col. 1.
45. Joao indicates that intermediaries may use the system to obtain healthcare information. Col. 4, ll. 26-32.

Any differences between the claimed subject matter and the prior art

46. Neither Segal nor Joao discloses the claim phrase “without data processing said medical record” or the employing a “service provider” to induce a patient to perform certain actions.

The level of skill in the art

47. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art of managing medical

records. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (*quoting Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

48. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). “[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the

applicant or patentee. Am. Acad., 367 F.3d at 1364.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1, 2, 5-8, 11-32, and 35-64 under 35 U.S.C. §103(a) as being unpatentable over Segal, Joao, and Official Notice.

The Appellant argued claims 1, 2, 5-8, 11-32, and 35-64 as a first group (Br. 19) and separately argued claims 2, 8, 19-29, 31, and 49 (Br. 30). We select claims 1 and 2 as the representative claims for these groups. The remaining claims stand or fall with claims 1 and 2. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The obviousness of the claimed subject matter of claims 1 and 2 over the cited prior art turns on the question of claim construction. “Analysis begins with a key legal question -- *what* is the invention *claimed*? Courts are required to view the claimed invention *as a whole*. 35 U.S.C. § 103. Claim interpretation, in light of the specification, claim language, other claims, and prosecution history, is a matter of law and will normally control the remainder of the decisional process.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987).

Generally-speaking, the claimed subject matter is directed to methods and a system for getting a patient’s medical records to a third party from a covered entity, such as a physician. To accomplish that, a “service provider”, who is not a patient or covered entity, is called upon to induce the patient to obtain the medical records from, for example, the physician. The method of claim 1 further requires the service provider to receive the medical record from the patient in a storage format, store it, obtain agreement from the patient to transmit the medical record to a third party, and transmit it to the third party. According to the method of claim 2, the service provider also induces

the patient to convert the received medical record into a storage format and to store it.

Giving the claims the broadest reasonable construction consistent with the specification as they would be interpreted by one of ordinary skill in the art (*see* FF 1-38), we find that claim 1 reasonably broadly reads on a process by which, for example, a mother (“service provider”) persuades (“induces”) her child (“patient”) to receive a medical record from the child’s doctor (“covered entity”) on a recordable CD (“storage format”), maintains the CD (“storing ... without data processing said medical record”), obtains an agreement from the child to allow transmission of the medical record to the child’s father (“third party”) when the father asks for it (“defined conditions”), and when the father asks for it, sends (“transmits”) the CD to the father. We find that claim 2 reasonably broadly reads on a mother persuading a child to convert a paper medical record into electronic form.

We now turn to the prior art.

There is no dispute that Segal and Joao disclose ways of providing health records to a patient. The question is whether one of ordinary skill in the art would have been led to the claimed subject matter given the Segal and Joao disclosures and giving the claims the broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art. We agree with the Examiner that one of ordinary skill in the art would have been led to the claimed subject matter given the Segal and Joao disclosures and

given what would have been well known to those of ordinary skill in the art at the time of the invention.

The difference between the claim subject matter and that of Segal and Joao is the addition of a service provider as an intermediary between the patient and a third party to perform certain actions, namely inducing the patient to obtain and convert the format of the obtained medical records. Given that a service provider can be anyone - including, for example, a parent of a child patient - and that one of ordinary skill would have known that individuals persuade others to get information - for example, parents persuading children to get information - one of ordinary skill in the art reading Joao and Segal would understand that the procedures described therein for a patient to obtain his/her medical records could be effected via someone other than the patient or covered entity (i.e., “service provider”) who would persuade the patient to obtain his/her medical records.

Another difference which the Appellant emphasizes is that the claims require certain steps/elements to be performed “without data processing said medical record.” Setting aside that we find inadequate written descriptive support for this limitation in the Specification (*see infra*), we do not find that such actions as receiving, storing, and transmitting a medical record, all of which are well known to those of ordinary skill in the art of managing medical records, are patentably distinguishable for being performed “without data processing said medical record.” We note that the Appellant concedes that Step B of claim 1 “would be performed if the patient scanned her own medical

record to a make a PDF file, stored the PDF record on a CD, and handed the CD to the service provider, then the service provider merely possessed the CD.” Br. 25. The Appellant then argues that adding steps C and E of claim 1, whereby the service provider also stores the record in memory and transmits it to a third party, renders the claimed subject matter nonobvious over the cited prior art. Notwithstanding that storing information in a memory is well known, a CD is a “memory” as the Appellant has defined that term (*see* FF17). Thus the mere holding of the CD that was produced in Step A. necessarily meets the requirements of Step C. As to the step of transmitting medical records to a third party, as we have reasonably broadly construed this step in the context of claim 1, this is commonplace. See FF30-32.

In our view, the Examiner was reasonable to reject the claimed subject matter under §103 over the cited prior art and what would have been well known to one of ordinary skill in the art of managing medical records.

Neither the enactment of § 103 nor the analysis in *Graham* disturbed this Court's earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art. For over a half century, the Court has held that a “patent for a combination which only unites old elements with no change in their respective functions ... obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 71 S.Ct. 127, 95 L.Ed. 162 (1950). This is a principal reason for declining to allow patents for what is obvious. *The combination of familiar elements according to known methods*

is likely to be obvious when it does no more than yield predictable results.

KSR at 415-416. Emphasis added. Accordingly, the rejection as to claims 1 and 2 is affirmed. Given that claims 5-8, 11-32, and 35-64 stand or fall with claims 1 and 2, their rejection is also affirmed for the same reasons.

Nevertheless, we recognize that we have relied on a more detailed claim construction analysis to show in what way the claimed subject matter is rendered obvious over the cited prior art and what was well known. Our reasoning in finding that the claimed subject matter would have been obvious to one of ordinary skill in the art departs from that of the Examiner. Accordingly, though we affirm the rejection of the claims 1, 2, 5-8, 11-32, and 35-64, we denominate the rejection as a new ground under 37 C.F.R. § 41.50(b).

The rejection of claims 33 and 34 under 35 U.S.C. §103(a) as being unpatentable over Segal, Joao, Official Notice, and Judson.

The Appellant relied on the arguments challenging the rejection of claims 1, 2, 5-8, 11-32, and 35-64. Br. 32. We affirm the rejection for the same reasons and because our reasoning in finding that the claimed subject matter would have been obvious to one of ordinary skill in the art departs from that of the Examiner, we denominate the rejection as a new ground.

The rejection of claims 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over Segal, Joao, Official Notice, and Mok.

The Appellant relied on the arguments challenging the rejection of claims 1, 2, 5-8, 11-32, and 35-64. Br. 33. We affirm the rejection for the same reasons and because our reasoning in finding that the claimed subject matter would have been obvious to one of ordinary skill in the art departs from that of the Examiner, we denominate the rejection as a new ground.

NEW GROUNDS

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 1, 2, and 5-64 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Principle of Law

Written Description

“What is claimed by the patent application must be the same as what is disclosed in the specification; otherwise the patent should not issue.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736 (2002). All that is necessary to satisfy the description requirement is to show that one is “in possession” of the invention. The decision in *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) accurately states the test.

One shows that one is ‘in possession’ of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. *Id.* (“[T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the ‘written

description' inquiry, *whatever is now claimed.*") (emphasis in original). One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. Although the exact terms need not be used in haec verba, *see Eiselstein v. Frank*, 52 F.3d 1035, 1038 . . . (Fed.Cir.1995) ("[T]he prior application need not describe the claimed subject matter in exactly the same terms as used in the claims"), the specification must contain an equivalent description of the claimed subject matter."

Lockwood v. Am. Airlines, Inc., 107 F.3d at 1572. Compliance with the written description requirement is a question of fact. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985).

Analysis

We reject claims 1, 2, and 5-64 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The independent claims are method claims 1 and 9 and system claim 30.

The limitation "without data processing said medical record" was first introduced into steps B., C., and E. of claim 1; step C. of claim 19; and, storage element B. of claim 30 by the Amendment filed Jun. 9, 2006. We find there is inadequate written descriptive support in the originally-filed Specification for this additional claim limitation.

The Jun. 9, 2006 Amendment (p.18) states that the limitation “without data processing said medical record” is supported by the following passage in the Specification:

[0037] In accordance with an embodiment of the invention, the medical information of a patient stored in a medical file storage system is provided by the patient, and is stored as the patient provides without any change or alteration to its content or format. In other words, a medical file storage system based on the present invention copies, stores, retrieves, and delivers medical information in the storage format as received from the patient, who obtained his or her own medical information from a covered entity. Such a medical file storage system is not a HCC [health care clearinghouse] because it does not process or facilitate the processing of health information received from a covered entity; it only receives and stores medical information of a patient that is provided by the patient himself or herself; ...

But the passage describes a medical file storage system that stores medical information in the format received from the patient. The passage does not describe any actions taken by a service provider, let alone that the actions of receiving, storing, and transmitting medical records by the service provider are to be conducted “without data processing [of] said medical record.” Also, the passage does not describe the medical file storage system in terms that precludes it from processing data. While the “medical file storage system based on the present invention copies, stores, retrieves, and delivers medical information in the storage format as received from the patient” (Specification [0037]), there is no indication the storage system performs these operations, or is limited to operations that perform, without data processing. The passage does not convey with reasonable

clarity to those skilled in the art that, as of the filing date sought, that the Applicant was in possession of the invention as now claimed, that is, a method whereby a service provider receives (claim 1, step B.), stores (claim 1, step C.), and transmits (claim 1, step E.) the medical record - all without data processing the medical record; a method whereby a service provider induces a patient to store the medical record without the service provider data processing the medical record (claim 9, step C.); and, a system comprising a storage device configured to store the “medical record without data processing said medical record” (claim 30, element B).

CONCLUSIONS

We conclude that the Appellant’s arguments do not overcome the rejection of claims 1, 2, 5-8, 11-32, and 35-64 under 35 U.S.C. §103(a) as being unpatentable over Segal, Joao, and Official Notice; claims 33 and 34 under 35 U.S.C. §103(a) as being unpatentable over Segal, Joao, Official Notice, and Judson; and, claims 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over Segal, Joao, Official Notice, and Mok. Because our reasoning differs substantially from that of the Examiner we denominate our affirmance of these rejections as new grounds of rejection.

We enter a new ground of rejection of claims 1, 2, and 5-64 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

DECISION

The decision of the Examiner to reject claims 1, 2, and 5-64 is affirmed.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED; 37 C.F.R. § 41.50(b)

Appeal 2009-005845
Application 10/679,749

mev

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